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**MAY 16 2005**

**OFFICE OF PETITIONS**

In re Application of	:	
Johnson et al.	:	DECISION ON PETITION
Application No. 09/778,131	:	
Filed: February 6, 2001	:	
Attorney Docket No. PHN 16,952A	:	

This is a decision on the petition under 37 CFR 1.137(a), filed January 24, 2005, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137." Extensions of time under 37 CFR 1.136(a) are permitted.

The above-identified application became abandoned for failure to timely pay the issue fee and the publication fee in response to the Notice of Allowance and Fee(s) Due mailed on January 30, 2002, which set a three-month statutory period to respond. The above-identified application became abandoned on May 1, 2002. A Notice of Abandonment was mailed on May 31, 2002.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) The petition fee as set forth in 37 CFR 1.17(l);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

This petition lacks item (3) above.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to be "unavoidable".<sup>3</sup> Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>4</sup>

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).<sup>5</sup> Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.<sup>6</sup>

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<sup>3</sup>35 U.S.C. § 133.

<sup>4</sup>In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

<sup>5</sup>See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

<sup>6</sup>Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

*With regard to requirement (3):*

Petitioners assert that they timely filed the Issue Fee Transmittal on April 29, 2002 and clearly intended to authorize the payment of the issue fee and publication fee via a Deposit Account. Petitioners explain they unexpectedly omitted the Deposit Account Number on the Issue Fee Transmittal. Petitioners state that the omission of the Deposit Account Number was the cause of the delay resulting in the abandonment of the application. Petitioners further state that they routinely utilize a Deposit Account in paying fee to the USPTO. Lastly, petitioners assert that the persons involved in the preparing/filing of the Issue Fee Transmittal are sufficiently trained with regard to such and that petitioners exercised due care in relying upon them to provide the Deposit Account Number on the Issue Fee Transmittal.

Initially, the Office notes:

An authorization to charge the issue fee or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee to any deposit account identified in a previously filed authorization to charge fees:

- (1) An incorrect issue fee; or
- (2) A completed Office-provided issue fee transmittal form (where no issue fee has been submitted).

37 CFR 1.311(b).

There is no indication in the record that petitioners previously submitted a general authorization to charge any necessary fees. Rather, the transmittal letter submitted on February 6, 2001, specifically authorizes the Office to charge any additional fee that may be required **except for the Issue Fee**. Petitioners' failure to include the Deposit Account Number on the Issue Fee Transmittal is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence. Moreover, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay.<sup>5</sup>

Because petitioner did not provide a sufficient showing that the delay was unavoidable within the meaning of 35 USC § 151 and 37 CFR 1.137(a), the petition is **dismissed**. In any renewed petition under 37 CFR 1.137(a), petitioner must submit a thorough explanation, including any documentary evidence, to support a showing of unavoidable delay.

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<sup>5</sup> See *Haines v. Quigg*, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891).

**Alternative Venue:**

Instead of filing a renewed petition under 37 CFR 1.137(a), petitioner should consider filing a petition pursuant to 37 CFR 1.137(b) on the basis of **unintentional** delay.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.
- (2) The petition fee as set forth in 37 CFR 1.17(m), an additional \$1,500.00 for a large entity;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

By mail:                      Mail Stop Petition  
                                    Commissioner for Patents  
                                    P.O. Box 1450  
                                    Alexandria, VA 22313-1450

By FAX:                      (703) 872-9306  
                                    Attn: Office of Petitions

By hand:                     Customer Service Window  
                                    Randolph Building  
                                    401 Dulany Street  
                                    Alexandria, VA 22314

The \$1,400.00 issue fee \$300.00 publication fee will be charged to Deposit Account No. 14-1270, as authorized by petitioners.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions